

### Remarks

This is a complete response to the pending Office Action mailed 11/1/2005. At the outset, Applicant expresses appreciation for the Examiner's responses to Applicant's previous arguments.

In response, these amendments and remarks are proper and do not add new matter, but more particularly point out and distinctly claim that which is the patentable subject matter in order to clarify Applicant's position that all claims are in condition for allowance.

This is a request for the Examiner to reconsider and withdraw the final rejection of all pending claims. Absent such reconsideration, this case is not in condition for appeal due to unresolved issues making all rejections of independent claims not proper and without basis. Following is an explanation of at least some of the unresolved issues discussed below.

The examination resulting in the anticipatory rejection of claims 1 and 25 is incomplete because it is based on the mischaracterization that Boutaghou '222 identically discloses *a first acceleration rate and a second acceleration rate, or multiple acceleration rates* as claimed. Absent the mischaracterization, the cited reference does not identically disclose all the features of the rejected claims. Thus, the Examiner has not substantiated a prima facie case of anticipation.

The examination resulting in the anticipatory rejection of claim 13 is incomplete because it is based on the mischaracterization that Boutaghou '222 identically discloses a *landing zone* as claimed. Absent the mischaracterization, the cited reference does not

identically disclose all the features of the rejected claim. Thus, the Examiner has not substantiated a prima facie case of anticipation.

### **Objection to Claims**

Claims 13-17 and 19 were objected to for mixing apparatus claim and method claim language together in the preamble. Applicant respectfully traverses this objection because independent claim 13 recites an apparatus comprising *circuitry* in terms of its functionality capabilities. When the structure-connoting term "circuit" is coupled with a description of the circuit's operation, sufficient structural meaning generally is conveyed to persons of ordinary skill in the art, and 35 USC § 112 ¶ 6 presumptively does not apply. *Linear Technology Corp. v. Impala Linear Corp.*, 72 USPQ2d 1065 (Fed. Cir. 2004); *Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1373 (Fed. Cir. 2003).

Nevertheless, Applicant has amended claim 13 without prejudice to obviate the Examiner's objection by replacing "a method" with "an exit sequence," thereby more particularly pointing out and distinctly claiming the patentable subject matter of the present embodiments. Withdrawal of the present objection is respectfully requested.

### **Rejection Under Section 102(e)**

Claims 1-3, 6, 7, 13-15, 19, and 25-34 were again rejected as being anticipated by Boutaghou '222. Applicant respectfully reiterates its earlier traversal of this rejection. (see Applicant's response of 8/5/2004)

Claim 1

Applicant reiterates that the Examiner has not substantiated the requisite prima facie case of anticipation of claim 1 as previously presented because Boutaghou '222 does not identically disclose *accelerating a medium at a first acceleration rate and accelerating the medium at a second acceleration rate*.

The Examiner relies on col. 9 lines 9-20 of Boutaghou '222 as disclosing *accelerating a medium at a first acceleration rate*. Absent further clarification from the Examiner, Applicant can only conclude the Examiner has mischaracterized Boutaghou '222 because this passage only describes rotating the disk at a first velocity in the range of 150 RPM to 1000 RPM, and preferably in the range of 200 RPM to 300 RPM. This passage, and indeed the entire disclosure of Boutaghou '222 is entirely silent regarding the acceleration methodology employed to obtain the desired velocity.

The Examiner relies on col. 9 lines 17-25 of Boutaghou '222 as disclosing *accelerating a medium at a second acceleration rate*. Again, Boutaghou '222 is wholly silent regarding the acceleration methodology employed to obtain the desired velocity. Particularly, Boutaghou '222 does not identically disclose obtaining the desired velocities by employing a *first acceleration rate* and a *second acceleration rate* as in the present embodiments as claimed.

The Examiner's basis for this rejection is erroneous because it relies on a mischaracterization of Boutaghou '222. Absent reconsideration, this case is not in condition for appeal because of the unresolved issue that the rejection is clearly not proper and without basis due to the legal deficiency associated with the Examiner's mischaracterization of the cited reference. Basing anticipation on a mischaracterization

of the cited reference violates the Examiner's obligation of competencess in considering the patentability of the present invention as claimed. 37 CFR 1.104(a) This case is also not in condition for appeal due to the unresolved issue that, absent the mischaracterization, the rejection is clearly not proper and without basis because the Examiner has failed to cite a reference that identically discloses all the recited features of the rejected claims, thereby failing to substantiate a prima facie case of anticipation.

Nevertheless, and solely in order to facilitate prosecution on the merits, Applicant has amended claim 1 without prejudice in order to more particularly point out and distinctly claim, in addition to the patentable distinction above, *moving a transducer over the medium...during one of the accelerating steps (a) and (b)...* Boutaghou '222 clearly discloses moving the transducer at the desired steady-state speed; in other words, when no acceleration is taking place:

Once the rotational speed of the disk 134 is achieved, a spindle motor controller (discussed in FIG. 11) sends a signal to the actuator controller which moves the actuator assembly 120 so that the slider is moved from the ramp 136 to a position over the disk 1344 surface....  
(Boutaghou '222, col. 9 lines 20-25, emphasis added)

Boutaghou '222 cannot sustain a Section 102 rejection of claim 1 because it does not identically disclose all the features of the present embodiments as claimed. Applicant respectfully requests reconsideration and withdrawal of the present rejection of claim 1 and the claims depending therefrom. Absent reconsideration, this case is not in condition for appeal because of the unresolved issue that the Examiner has failed to substantiate a prima facie case of anticipation.

Claim 13

Applicant reiterates that the Examiner has not substantiated the requisite prima facie case of anticipation of claim 13 because Boutaghou '222 does not identically disclose *moving a transducer from a landing zone....* (see Applicant's response of 8/5/2004)

Although the Examiner agreed with Applicant's argument that the load/unload ramp of Boutaghou '222 does not identically disclose the recited *landing zone* of claim 13, the Examiner nevertheless maintained the rejection by stating: "it is certainly functioned as a landing zone for a transducer to land on for parking." (Office Action of 11/1/2005, para. 5)

The "all elements" rule for substantiating anticipation requires that all recited elements be identically shown in a single reference and arranged as in the claim under review. *C.R. Bard, Inc. v. M3 Systems, Inc.* 48 USPQ2d 1225 (Fed. Cir. 1998); *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). The Applicant expressly traverses the Examiner's assertion that a loading ramp functions as a *landing zone* in view of the claim term's common meaning to the skilled artisan and consistent usage therewith in the specification. The skilled artisan readily recognizes that the present embodiments as claimed do not contemplate loading/unloading the transducer to a ramp.

For example, the present embodiments contemplate *as the storage disc rotates at any of the group consisting of the first rotational velocity and the second rotational velocity, moving a transducer from a landing zone to a region of the storage disc.*

Contrarily, Boutaghou '222 discloses moving the transducer to the storage disk only at

the lower velocity. This limitation minimizes damage in Boutaghou '222 which relies on making contacting engagement between the transducer and the disk during loading:

A method for loading a slider from a ramp to a disk surface includes rotating the disk at a first rotational velocity, as the slider is loaded. The disk is rotated at a second rotational velocity after the slider is positioned over the disk. The first rotational velocity is slower than the second rotational velocity so that damage due to contact between the disk and slider is minimized.

(Boutaghou '222, Abstract, emphasis added)

Accordingly, the Examiner has not substantiated a prima facie case of anticipation because Boutaghou '222 does not identically disclose all the features of the present embodiments as claimed. By reading the ramp of the cited reference onto the recited *landing zone* the Examiner has mischaracterized the reference and thereby effectively ignored explicitly recited claim language of claim 13.

The Examiner's basis for this rejection is erroneous because it relies on a mischaracterization of Boutaghou '222. Absent reconsideration, this case is not in condition for appeal because of the unresolved issue that the rejection is clearly not proper and without basis due to the legal deficiency associated with the Examiner's mischaracterization of the cited reference. Basing anticipation on a mischaracterization of the cited reference violates the Examiner's obligation of completeness in considering the patentability of the present invention as claimed. 37 CFR 1.104(a) This case is also not in condition for appeal due to the unresolved issue that, absent the mischaracterization, the rejection is clearly not proper and without basis because the Examiner has failed to cite a reference that identically discloses all the recited features of the rejected claims, thereby failing to substantiate a prima facie case of anticipation.

Applicant respectfully requests reconsideration and withdrawal of the present rejection of claim 13 and the claims depending therefrom. Absent reconsideration, this case is not in condition for appeal because of the unresolved issue that the Examiner has failed to substantiate a prima facie case of anticipation.

#### Claim 25

Applicant reiterates that the Examiner has not substantiated the requisite prima facie case of anticipation of claim 25 because Boutaghou '222 does not identically disclose *circuitry for accelerating the medium at multiple acceleration rates*....

As discussed above, Boutaghou '222 is wholly silent regarding *accelerating the medium at multiple acceleration rates*. The passages on which the Examiner relies (col. 9 lines 25-30, col. 10 lines 22-24, 34-37) disclose operating at different velocities but not *multiple acceleration rates*. As above, absent further clarification from the Examiner, Applicant can only conclude the Examiner has mischaracterized Boutaghou '222.

The Examiner's basis for this rejection is erroneous because it relies on a mischaracterization of Boutaghou '222. Absent reconsideration, this case is not in condition for appeal because of the unresolved issue that the rejection is clearly not proper and without basis due to the legal deficiency associated with the Examiner's mischaracterization of the cited reference. Basing anticipation on a mischaracterization of the cited reference violates the Examiner's obligation of completeness in considering the patentability of the present invention as claimed. 37 C.F.R. 1.104(a) This case is also not in condition for appeal due to the unresolved issue that, absent the

mischaracterization, the rejection is clearly not proper and without basis because the Examiner has failed to cite a reference that identically discloses all the recited features of the rejected claims, thereby failing to substantiate a prima facie case of anticipation.

Applicant respectfully requests reconsideration and withdrawal of the present rejection of claim 13 and the claims depending therefrom. Absent reconsideration, this case is not in condition for appeal because of the unresolved issue that the Examiner has failed to substantiate a prima facie case of anticipation.

#### **New Claim**

Applicant has canceled claim 30 and replaced it with new claim 35. Claim 35 is patentably distinct over the art of record which does not disclose or suggest a *predetermined acceleration profile* such as is supported by the disclosure of FIG. 6 and the discussions thereof in the specification.

#### **Conclusion**

This is a complete response to the pending Office Action of 11/1/2005.


Applicant has also filed herewith a Request for Telephone Interview to be held before the Examiner makes the next action on the merits. The interview is necessary, absent allowance, to settle the unresolved issues making this case presently not in condition for appeal.



Should any questions arise concerning this application, the Examiner is encouraged to contact the below signed attorney.

Respectfully submitted,

By:



Mitchell K. McCarthy, Registration No. 38,794  
Randall K. McCarthy, Registration No. 39,297  
Fellers, Snider, Blankenship, Bailey & Tippens  
100 North Broadway, Suite 1700  
Oklahoma City, OK 73102-8810  
Telephone: (405) 232-0621  
Fax: (405) 232-9659